

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CORA JOHNSON

Appeal No. 2002-1054
Application No. 09/436,333

ON BRIEF

Before MCQUADE, NASE and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20, which are all of the claims pending in this application.

The appellant's invention relates to a container (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|--------------------------|-----------|---------------|
| Sebring | 1,696,456 | Dec. 25, 1928 |
| Eastman et al. (Eastman) | 2,478,470 | Aug. 9, 1949 |
| Schmidt | 2,619,251 | Nov. 25, 1952 |
| Cooley | 3,647,102 | Mar. 7, 1972 |

The rejections

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Eastman.

Claims 1, 2, 7 and 10-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman.

Claims 3 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman as applied to claims 1, 2, 7, and 10 to 19, and further in view of Schmidt.

Claims 8, 9, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman as applied to claims 1, 2, 7, and 10 to 19 and further in view of Sebring.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final

rejection (Paper No. 4, mailed March 8, 2001) and the answer (Paper No. 8, mailed December 11, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 6, filed August 15, 2001) and reply brief (Paper No. 9, filed January 25, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claim 1 as anticipated by Eastman. The appellant has not discussed this rejection in either the brief or the reply brief. Therefore, we will summarily affirm this rejection.

We turn next to the examiner's rejection of claims 1, 2, 7 and 10 to 19 under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman. In support of this rejection, the examiner concludes that it would have been obvious to employ the top plate and groove mount teaching set forth in Eastman in the construction of the device of Cooley motivated by the flush top achieved thereby.

Appellant argues the suggestion of adapting Cooley by Eastman can be made only in the light of the invention. We agree. We find nothing in Cooley that suggests that a flush top is desirable. In fact, in our view a flush top may interfere with the items contained in the Cooley container. We note that Cooley discloses that the cover is slightly elevated so that the cover is free to slide back and forth from a closed to an open position without binding and with a minimum of friction (col. 3, lines 24 to 29).

In view of the foregoing, we will not sustain the rejection as it is directed to claim 1 and claims 2, and 7 dependent thereon.

In regard to claim 10, we note that Eastman discloses a method of fabricating a container having an exterior and an interior storage capability which comprises the steps recited in claim 10. In addition, Cooley likewise discloses a method of fabricating a container having an exterior and an interior storage capability which comprises the steps recited in claim 10. As such, in our view, either Eastman or Cooley anticipates the subject matter recited in claim 10 because each reference alone discloses each and every step of claim 10. We note that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA

1974). Thus, we sustain the examiner's rejection of appealed claim 10 under 35 U.S.C. § 103.

We will also sustain the rejection as it is directed to claim 11 because each one of Eastman and Cooley discloses a quadrilateral with pairs of opposing walls.

In regard to claims 12 and 13, we note that Eastman discloses that the support member is a planar plate and that the quadrilateral includes separate wall supports for the planar plate. Therefore, we will sustain the rejection as it is directed to claims 12 and 13.

Claim 14 recites that the quadrilateral includes wall-mounted rollers to facilitate the slidable movement of the support member. The examiner states:

It would have been obvious to one of ordinary skill in the art to have employed standard roller draw hardware in the construction of the device of Cooley as modified above by Eastman, et. al., motivated by the ease of operation achieved thereby. [answer at page 3]

In our view, there is no motivation of including rollers in either the Eastman or Cooley container. The examiner's conclusion that the inclusion of rollers would achieve ease of operation is speculative in nature and is not based on a factual basis. A rejection based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded

assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

In view of the foregoing, we will not sustain this rejection as it is directed to claim 14.

Claim 15 recites the step of placing items upon a slidable cover plate. We will not sustain this rejection as it is directed to claim 15 and claims 16 to 19 dependent thereon because neither Eastman nor Cooley discloses placement of items on a slidable cover plate and as we discussed above, there is no motivation to combine the teachings of Eastman and Cooley.

We turn next to the examiner's rejection of claims 3 to 6 under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman as applied to claims 1, 2, 7 and and further in view of Schmidt. We have reviewed the disclosure of Schmidt and determined that Schmidt does not cure the deficiencies noted above for the combination of Cooley and Eastman. Therefore, we will not sustain this rejection for the same

reasons stated above in regard to the examiner's rejection of claim 1 under 35 U.S.C. § 103.

We turn lastly to the examiner's rejection of claims 8, 9 and 20 under 35 U.S.C. § 103 as being unpatentable over Cooley in view of Eastman as applied to claims 1, 2, 7, and 10 to 19 above and further in view of Sebring. We have reviewed the disclosure of Sebring and determined that Sebring does not cure the deficiencies noted above for the combination of Cooley and Eastman. Therefore, we will not sustain this rejection of claims 8, 9 which are dependent on claim 1 for the same reasons stated above in our discussion of the rejection of claim 1 under 35 U.S.C. § 103.

In regard to claim 20, we have reviewed the disclosure Sebring and determined that Sebring does not cure the deficiencies noted above for Cooley and Eastman in our discussion of the rejection under 35 U.S.C. § 103 of claim 15 from which claim 20 depends. Therefore, we will not sustain this rejection for the same reasons given in our discussion of the rejection of claim 15 under 35 U.S.C. § 103.

In summary:

The examiner's rejection of claim 1 under 35 U.S.C. § 102 is sustained.

The examiner's rejections of claims 1, 2 to 9, 14 to 20 under 35 U.S.C. § 103 are not sustained.

The examiner's rejection of claims 10 to 13 under 35 U.S.C. § 103 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN -PART

JOHN P. MCQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

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